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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/020,759 | 12/13/2001 | Richard L. Galloway | 50046 | 3883 |
| 22929 | 7590 | 10/07/2005 | EXAMINER | |
| SUE Z. SHAPER, P.C. 1800 WEST LOOP SOUTH SUITE 1450 HOUSTON, TX 77027 | | | LE, KHANH H | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3622 | |

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|----------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/020,759 | GALLOWAY, RICHARD L. | |
| | Examiner | Art Unit | |
| | Khanh H. Le | 3622 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This Office Action is responsive to the original application filed 12/13/01.

No Requirement for Restriction.

2a. In a telephone conversation on 9/21/05, Ms. Sue Shaper, representing Applicants, stated that claims 1 –20, 27-28 would be elected if a restriction requirement is made. Upon further consideration, no restriction requirement is herein made, so the issue is moot.

Objections to Specifications

2b. At page 5, Figures 3A-1, 3A-2 and 3B-1, 3B-2 should be mentioned instead of just Figures 3A and 3B. Table 4 is missing, contrary as stated on page 6. Appropriate correction is required.

Rejections - 35 USC § 112

3. **Claims 7-13, 18, and 25, 27-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

As to claims 7, 10, 13 : “by advertising client” is unclear. This phrase might be interpreted as if the client compiles the report. Appropriate correction is required. It is interpreted the report is compiled for each advertising client.

Claims 7-12, 18, and 27, : On 9/21/05, Ms. Sue Shaper discussed that claims 7-12 are meant to be method claims paralleling claims 13-17. Presently claim 7 is a system claim. Appropriate correction is required. For prior art application purposes, claims 7-12, 18, and 27 are interpreted as being method claims.

Claim 18: is identical to claim 8, thus one or the other is to be cancelled.

Claim 25: Ms. Shaper stated that claim 25 should be dependent on claim 21 instead of claim 1. Appropriate correction is required.

Claim 28: Ms. Shaper stated that claim 28 should be dependent on claim 1 instead of claim 27. Appropriate correction is required.

For prior art application purposes, claims 25 and 28 are so interpreted.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. **Claims 1-20, 27-28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 09/947,730.**

Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application 09/947,730 recites transmitting, prior to broadcast, a report on ads to be run in a future period while the instant claims claim transmitting a report on ads as-run in a past period.

It is admitted at Specifications [0006] that "Prior to the present invention, when a client advertiser or broadcast media wanted advance notice of the times/channels/stations/site- s

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scheduled for airing that client's ads, the request entailed significant human intervention. The same is true for "as-run" reports... Typically, a person associated with a communication company would first need to review a record of which clients wanted such advance notice of scheduled times and locations for ad airing, or "as-run" reports. The person would then typically manually request a "traffic and billing system" (or some equivalent) to download a scheduled time/site report or verified run report for or including that client." Thus a report on ads to be run in a future period as well as a report on ads run in a past period are admittedly known and are compiled manually from data derived partly from traffic and billing systems. Both applications claim compiling reports automatically instead of manually.

It would have been obvious to one skilled in the art at the time the invention was made to use as-run data from traffic and billing systems and substitute them to the advance notice data in the automated reporting method and systems, as claimed in application 09/947,730 for the advantage of sending reports on as-run ads, in an automated and efficient manner, paralleling the manual reporting process on advance-notice and "as-run" ads disclosed in the Specifications.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over admitted art in view of Rogers et al, US 5701451 A.

As to claims 1-2, and 4:

communicating a timing of ad broadcasts by accessing at least one electronically stored record indicating times for ads broadcast in a (past) period;
generating a client report including at least a time for a broadcast of an ad in a period; and
transmitting the report to an advertising client is admittedly known to be done manually (Specifications page 2, Fig 1A).

Further accessing an electronically stored record generated at least in part by broadcast inserter equipment and accessing an electronically stored record generated at least in part by a traffic and billing system manually is also admittedly known (Specifications [0005] to [0008], Fig 1A)..

Transmitting such report by fax is also admittedly known (Specifications [0005] to [0008], Fig 1A).

However, it is not admitted the above steps are automated.

However, it was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of culling the needed information and manipulating the data to produce the report automatically as claimed gives you just what you would expect from the manual step as admitted. In other words there is no enhancement found in the claimed steps. The claimed steps above only provide automating the manual activity. The end result is the same as compared to the manual method. A computer can simply produce the report faster. The result is the same.

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It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the above discussed steps because this would speed up the process of producing a report for clients, which is purely known, and an expected result from automation of what is known in the art.

Further, Rogers discloses:

A World Wide Web browser makes requests to web servers on a network which receive and fulfill requests as an agent of the browser client, organizing distributed sub-agents as distributed integration solution (DIS) servers on an intranet network supporting the web server which also has an access agent servers accessible over the Internet. DIS servers execute selected capsule objects which perform programmable functions upon a received command from a web server control program agent for retrieving, from a database gateway coupled to a plurality of database resources upon a single request made from a Hypertext document, requested information from multiple data bases located at different types of databases geographically dispersed, performing calculations, formatting, and other services prior to reporting to the web browser or to other locations, in a selected format, as in a display, fax, printer, and to customer installations or to TV video subscribers, with account tracking.

Thus Rogers discloses electronically grabbing information from multiple sources and formatting the information in any way desirable, which is the equivalent of Applicant's reporting step as a report is essentially a form. Thus the technology capable of doing the automated step of an admittedly known manual step is available, which lends support to the application of In re Venner in this instance.

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(Further it also noted, as to claim 2, that the system being called a “traffic and billing” system also is not given weight because the name of the system does not impact the method step as well. *Ex parte Pfeiffer* (see more details below).

As to claim 3, automatically generating and transmitting a plurality of reports is obvious if many advertiser clients or different ad campaigns for the same client are involved to make each report relevant to the subject matter/client.

As to claim 5, including an ad in a communication with a client is well-known, such as including a logo or a company motto, to remind the client of the nature and/or quality of one’s service or to apprise of a discount, thus including an advertising banner in a transmission of the report in this case, would have been obvious for the same marketing reasons.

As to claim 6, “an account manager for the client” is not given patentable weight as the title of the recipient does not impact the method step.

See Ex parte Pfeiffer, 135 USPQ 31 (BdPatApp&Int 1961) which held that, “to be entitled to such weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure”. In this case, there does not seem to be any impact on the manipulative steps of the method because of the name of the recipient, similar to the reasoning in *Ex parte Pfeiffer*.

As to claim 19 (dependent on claim 1), generating a report including a title of an ad would have been obvious to indicate which ad it relates to.

As to claims 7-16, and 18,

It is admitted "traffic and billing programs" to schedule ads or spots for one or for a variety of media at a variety of times and possibly a variety of geographical locations over a

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designated period for a set of advertising clients, as per the clients' contracts are well-known. A traffic and billing system, at least shortly before a designated period begins, produces a record (such as a Schedule Log or an Event Log and/or an Inserter Log) of all scheduled spots for ads on the set of media the communications company manages within a next designated period. Specifications at [0039]. Thus "compiling a schedule log" is admittedly well-known. Also see Specifications at [0052].

Further verification logs or (verified files logs) are admittedly typically produced by a system's commercial insertion equipment and returned to a traffic and billing system. Specifications at [0011], [0073], FIG. 1B.

Further, a verified file is admittedly "typically assumed to be associated with a version of a Schedule Log, indicates times that each ad was actually run. If an ad for whatever reason was not run, that too is indicated." Specifications at [0073]. Thus "outputting a measure of the effectiveness of a broadcast media in executing advertising in accordance with schedule log being an indicia of an omitted ad" is admittedly known.

Accessing a schedule log, compiling a schedule report, and transmitting the report to advertisers clients admittedly has been done manually. As discussed above, automation of manual processes (compiling the report) is not patentable in view of In Re Venner and Rogers, as discussed above.

As outputting a measure of the effectiveness of a broadcast media in executing advertising in accordance with schedule log being an indicia of an omitted ad is admittedly known, it would have been obvious to one skilled in the art at the time the invention was made to also add this data to the report in order to apprise the client of the success of the insertion and/or the reasons of non-insertion. Specifications at [0073]. Again, as to this additional data, Rogers also shows the capability of grabbing this information to automate manipulation and reporting of the data as desired.

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Further, reporting for each advertising client is obvious to make sure the report is addressed to the right client.

Further, automatically generating and transmitting a plurality of reports is obvious if many advertiser clients are involved to serve all these clients.

As to claim 17, it is admitted the manual reporting procedures apply both to advance notice of ads to be run as well as “as run” ads. Specifications [0006]. It would have been obvious to one skilled in the art at the time the invention was made to add transmitting a schedule report prior to a broadcast to the automatic reporting of as-run ads method so far discussed, to add further value to the automatic reporting (of as-run ads) method by providing automatically and efficiently advance notice of ads to be run. Since it is admitted the relevant needed data (for as run ads and for advance notice) are readily available for report compilation, if desired, and has been so done manually, it would have been obvious to one skilled in the art at the time the invention was made to do the same automatically for the obvious efficiency advantages.

As to claim 20, as to the accessed data ,being “media, times, client and title” it is noted those claimed data are non-functional descriptive material because it is not claimed what is done with that data after the steps of accessing (which also logically includes identifying) . Claims 7 and 13 boil down to accessing a database file, generating a report from accessed data, then transmitting the report. Further the accessed records including media, time, and titles of the ad are either explicitly or implicitly admittedly known (see [0005],[0006] “scheduled times and locations for ad airing”) .

Further, as to claim 20, the data being created by “different” systems does not impact the positive step of identifying such data, thus “created by different... systems” is not entitled to patentable weight. See *Ex parte Pfeiffer*, 135 USPQ 31 (BdPatApp&Int 1961) which held that, “to be entitled to such weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense and not to amount to the mere claiming of a use of a

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particular structure". In this case, there does not seem to be any impact on the manipulative steps of the method because of the number of systems involve which creates the data before they are later accessed/identified. (It is noted however that Rogers teaches grabbing data from many data sources, so even if "created by different... systems" is given patentable weight, the admitted art in view of Rogers disclose the method of claim 20.)

As to claims 21-26, 27-28, the limitations of these claims that are common to the previous claims are rejected as discussed above. Further ratings service files, such as Nielson ratings, are admittedly known and typically transmitted to broadcasters by media the subsequent day. Specifications at [0011] and [0072].

It would have been obvious to one skilled in the art at the time the invention was made to add Nielson ratings to the report to provide clients with further additional valuable information. Again, as to this additional data, Rogers also shows the capability of grabbing this information to automate manipulation and reporting of the data as desired.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nemirofsky et al., US 5761601 A, discloses distribution of full motion video media, usually in the form of advertisements to a plurality of businesses, such as retail businesses. The verification data processing computer receives verification data or other message data from the insertion control unit in the receiving site, and compare this data with the transmission record messages from system control computer to determine whether transmission was

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successful. The resulting data may be stored for statistical record-keeping and/or output to a display or printer (see at least Figs. 2 and associated text).

Greenberg US 4547804 A discloses method and apparatus for identifying and verifying the proper airing of television broadcast programs and commercials. "Verified airings" are compared with the "bought airings" so as to produce an analysis (i.e. a report) of that which was bought to that which was actually properly aired (see at least col. 2 lines 1-5; col.3 lines 1-30)

Wade, US PGPub 2002/0019831, discloses an *advertisement delivery server, an ad delivery verification server and ad reporting server* which can perform various types of queries or data manipulations in order to provide useful information to the advertiser server (see [0076], [0077]). 0077].

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

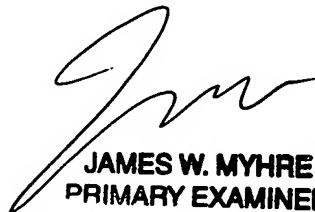
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 26, 2005


KHL


JAMES W. MYHRE
PRIMARY EXAMINER